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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,323	12/12/2001	Jill Deikman	38-21(52274)B	8906

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08/26/2003

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EXAMINER

MARTINELL, JAMES

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 08/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,323

Applicant(s)

DEIKMAN ET AL.

Examiner

James Martinell

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1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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Applicant's election with traverse of the requirement for restriction in Paper No. 4 (filed June 12, 2003) is acknowledged. The traversal is on the ground(s) that the search of Groups I and II would pose no undue burden on the Examiner. Applicants also disagree that each nucleotide sequence is necessarily a patentably distinct species. This is not found persuasive because applicants do not address the issue of independence and distinctness of Groups I and II is not addressed. In addition, the sequences of the application were not characterized as species, but as separate, independent, and distinct inventions. The assertion that there is no serious burden of search for Groups I and II is not convincing because in order to search (without calculating alignments) all 17,880 claimed nucleotide sequences alone it would require more than 1 year and 6 months of computing time using the sources available to the USPTO. A considerable amount of human resources would be required to evaluate and interpret the results of the searches and to retrieve and evaluate potential prior art references. Each and all of these tasks form a serious search burden for the USPTO.

The requirement is still deemed proper and is therefore made FINAL.

Claim 3 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4 (filed June 12, 2003).

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Embedded hyperlink and/or other form of browser-executable code appear in at least the following locations:

- (a) page 4, lines 9, 10, and 11;
- (b) page 5, lines 25-26;
- (c) page 25, lines 13 and 14; and
- (d) page 46, line 46.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite.

- (a) The recitation of "fragment thereof" (claim 1) is vague and indefinite because no lower limit for the fragment size is recited.
- (b) Claims 1, 4, and 5 are vague and indefinite because they claim more than was elected.
- (c) The recitation of "structural nucleic acid molecule" (claims 4 and 5) is vague and indefinite because the instant application does distinguish a structural nucleic acid from a non-structural nucleic acid.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The instant application does not disclose a specific, substantial, and credible utility for either SEQ ID NO: 8 or a polypeptide encoded by SEQ ID NO: 13 nor is a specific, substantial, and credible utility readily apparent to one of skill in the art from the disclosure and what is known in the art.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant application does not disclose a specific, substantial, and credible utility for either SEQ ID NO: 13 or a polypeptide encoded by SEQ ID NO: 13 nor is a specific, substantial, and credible utility readily apparent to one of skill in the art from the disclosure and what is known in the art. Thus, the instant application does not teach how to use the claimed invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Seiberler et al (EMBO J. 13: 3481 (1994)). Seiberler et al discloses a cDNA clone (clone 16) which encodes BET VIII (see Figure 1 and the paragraph bridging pages 3481-3482 and Appendix: Seiberler et al attached to this Office action), which encodes a 3-mer contained within SEQ ID NO: 13 and thus qualifies as a "fragment." Thus, the cDNA of Seiberler et al is embraced by claim 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (703) 308-0296. The fax phone number for Examiner Martinell's desktop workstation is (703) 746-5162. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 305-4028.

PLEASE NOTE THE NEW FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


James Martinell, Ph.D.
Primary Examiner
Art Unit 1631

Attachments

Appendix: Seiberler et al